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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,044	01/28/2002	David B. Sutton	6778-000001/COB	6585
27572	7590	04/09/2004	EXAMINER	
HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303			POINVIL, FRANTZY	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/060,044	Applicant(s) SUTTON ET AL.	
	Examiner Frantzy Poinvil	Art Unit 3628	<i>Mk</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 15-19, 21-30 and 32-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Risafi et al. (US Patent No. 6,473,500).

As per claim 15, Risafi et al disclose a method of distributing an electronic cash card (see the abstract) comprising the steps of:

providing an unfunded cash card to a retail outlet from a purchase intermediary;

associating the cash card with data in a data file, wherein the data file indicates that the card has not been funded;

funding the cash card at the retail outlet upon purchase of the cash card for a predetermined value by a purchaser;
updating the data file upon funding of the cash card at the retail outlet; and
remitting a fee to the retail outlet after the cash card has been funded.

As per these features, applicant is directed to column 3, line 53 to column 5, line 10 and column 7, line 47 to column 8, line 34.

As per claim 16, Risafi et al disclose the step of activating the cash card by registration with the purchase intermediary (column 11, line 58 to column 12, line 52)..

As per claim 17, Risafi et al disclose the step of remitting a commission to the retail outlet upon activation of the cash card (column 11, line 58 to column 12, line 52).

As per claim 18, Risafi et al disclose comprising providing the cash card to the retail outlet via a distributor of goods to the retail outlet other than the cash card (column 3, line 52 to column 4, line 16).

As per claim 19, Risafi et al disclose the step of selling the card to the retail outlet for an amount less than the predetermined value of the card (column 11, line 58 to column 12, line 52).

As per claim 21, Risafi et al disclose the step of providing an unfunded cash card further comprises ordering the cash card from a credit card provider. See figures 4, and 5a and 5b.

As per claim 22, Risafi et al disclose the credit card provider associates the cash card with data in a data file. See figures 4 and 5a and 5b.

As per claim 23, the step of manufacturing the cash card with a cash card carrier for supporting the cash card is inherent in the system of Risafi et al.

24. The method of claim 23 further comprising the step of providing at least one of advertisement and coupons on the cash card. See column 17, line 65 to column 18, line 3 and column 8, lines 15-21 of Risafi et al.

As per claim 25, Risafi et al disclose the steps of: activating the cash card over a network by registering the purchased cash card with the purchase intermediary; and providing at least one of advertisement and coupons over the network for presentation to the purchaser. See column 17, line 65 to column 18, line 3 and column 8, lines 15-21; and column column 8, lines 53-67 of Risafi et al.

Claims 26-30 and 32-35 contain similar limitations addressed in claims 15-19 and 21-25, and therefore are rejected under a similar rationale.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Risafi et al. (US Patent No. 6,473,500).

As per claims 20 and 31, the teachings of Risafi et al are discussed above. Risafi et al does not explicitly state selling the card to the retail outlet for an amount more than the predetermined value of the card. Such would have been obvious to one of ordinary skill in the art at the time of the invention to do in the system of Risafi et al in order to maximize profit in selling a card.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-35 are rejected under 35 USC 101 because it is directed to non-statutory subject matter, specifically as directed to an abstract idea.

The basis of this rejection is set forth in a two prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.


Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday-Thursday 7:00AM-5:30PM.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

FP
April 3, 2004


FRANTZY POINVIL
PRIMARY EXAMINER
A 12 628